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| 24203 7590 09/16/2008 GRIFFIN & SZIPL, PC SUITE PH-1 2300 NINTH STREET, SOUTH ARLINGTON, VA 22204 | | | | |
| EXAMINER | | | | |
| OBEID, FAHD A | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/525,873

Applicant(s)

DATE ET AL.

Examiner

FAHD A. OBEID

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/25/2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-11 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 25 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-859)
Paper No(s)/Mail Date 11/03/2006 and 08/25/2008
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Status of the Application

1. **Claims 1-11** are pending in this application.

Drawings

2. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.
3. The drawings are objected to because figure 6 contains a typo "burying form I" instead of "buying form I". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several

views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claims 1, 2, and 9 recite the limitations "the secondarily", "the consumer distribution", and "the false labeling preventing method" respectively. There is insufficient antecedent basis for the limitations in the claims.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Seiichiro (EP 1205405).

9. Regarding Claim 1: Seiichiro discloses a false labeling preventing method in commodity distribution, comprising the steps of:

- Receiving from a supplier a buying form I of commodity information, which is incapable of being falsified (attaching a tag to an item which passes through multiple stages such as manufacture stage; col 1 para 1).
- Preparing a shipping form O including all contents of the buying form and new commodity information and incapable of being falsified based on the buying form I (the tag which is attached to an item passes through multiple stages from manufacture to disposal and having stage storage areas as many as the stages of the life cycle, each stage storage area being identified by a different secret stage identifier, the access device including an identifier accepting unit for accepting an access identifier, a secret sending unit for sending the access identifier in secrecy to the tag, and an access information sending unit for sending access information to the tag; col 7 para 45 and col 11 para 93).
- Attaching the shipping form to the secondarily processed commodity and shipping the commodity (attaching a tag to an item such as foodstuff, cloths, or

miscellaneous article that passes through multiple stages such as manufacture stage, and accessing the tag to manage the item; col 55 para 378).

10. Regarding Claim 2: Seiichiro discloses a false labeling preventing method in the consumer distribution according to claim 1, further comprising the steps of:

- Using information erasable and writable labels as the buying form I and shipping form O incapable of being falsified, each of the labels comprising a read-only storage region written in a mode in which a serial number N is incapable of being erased, and an erasable writable storage region for writing the commodity information (to write product information to the tag, the product information is written to the ROM if the user wants the product information to be non-erasable, whereas the product information is written to the RAM when the user wants the product information to be erasable; at least para 321).
- Writing the supplier's commodity information and the serial number N of the buying form I in a two-dimensional code of the buying form I in a mode incapable of being falsified (writing product information in secrecy to the tag for each stage; para 57; also information on the date and time of writing may be added to the product information written in the common product information memory unit; col 48 para 311 and col 40 lines 15-29).
- Writing at least some of the contents of the two-dimensional code of the buying form I, the new commodity information, and the serial number N of the shipping

form O in the two-dimensional code of the shipping form O in the mode incapable of being falsified (para 57, col 48 para 311, and col 40 lines 15-29).

11. Regarding Claim 3: Seiichiro discloses a false labeling preventing method in the commodity distribution according to claim 2, wherein the label is a rewritable label and/or a label with an IC chip, with respect to which it is possible to erase and write the information, the read-only storage region is a barcode or ROM written in a mode in which it is impossible to erase the serial number N, and the writable storage region is an erasable two-dimensional code and/or RAM (tampering of data in a tag can be prevented by employing ROM memory; paras 172, 317, and 321).

12. Regarding Claim 4: Seiichiro discloses a false labeling preventing method in the commodity distribution according to claim 2, wherein the mode of the buying form I incapable of being falsified comprises commodity information and its issuer name encrypted by a secret key inherent in the supplier, and the mode of the shipping form O incapable of being falsified comprises commodity information and its issuer name encrypted by a secret key inherent in the shipper (col 3 lines 1-15, col 14 paras 114-115, col 17 lines 24-38, col 47 paras 304-306, and col 51 para 335).

13. Regarding Claim 5: Seiichiro discloses a false labeling preventing method in the commodity distribution according to claim 2, wherein the mode of the buying form I incapable of being falsified comprises commodity information and its public key

encrypted by a secret key inherent in the supplier, and the mode of the shipping form O incapable of being falsified comprises commodity information and its public key encrypted by a secret key inherent in the shipper (col 3 lines 1-15, col 14 paras 114-115, col 17 lines 24-38, col 47 paras 304-306, and col 51 para 335).

14. Regarding Claim 6: Seiichiro discloses a false labeling preventing method in the commodity distribution according to claim 2, wherein the mode of the buying form I incapable of being falsified comprises commodity information to which electronic signature inherent in the supplier has been attached, and the mode of the shipping form O incapable of being falsified comprises commodity information to which electronic signature inherent in the shipper has been attached (col 3 lines 1-15, col 14 paras 114-115, col 17 lines 24-38, col 47 paras 304-306, and col 51 para 335).

15. Regarding Claim 7: Seiichiro discloses a false labeling preventing method in the commodity distribution according to claim 1, further comprising the steps of: checking falsification capability of the buying form I using a label writing apparatus capable of reading, erasing, and writing the label; and preparing the shipping form O adapted to the buying form I only in a case where "falsification capability: NO" (col 4 paras 26 & 32, col 13 para 108, and col 51 para 336).

16. Regarding Claim 8: Seiichiro discloses a false labeling preventing method in the commodity distribution according to claim 7, further comprising the steps of:

- Reading the read-only storage region and the writable storage region of the buying form I (a device that is cable of reading/writing information from/to a tag for each stage; col 1 para 6).
- Checking legitimacy of the supplier's public key or electronic signature, and identity of the serial numbers of the read-only storage region and the writable storage region (col 6 para 39).
- Judging that "falsification capability: NO" only in a case when the public key or the electronic signature is legitimate and the serial numbers are the same (col 6 para 39).

17. Regarding Claim 9: Seiichiro discloses a false labeling preventing method further comprising the steps of:

- Writing at least some of the contents of the two-dimensional code of the buying form I, new commodity information, and the serial number N of the shipping form O in the writable storage region of the shipping form O in a mode incapable of being falsified (para 57, col 48 para 311, and col 40 lines 15-29)).
- Setting a new shipping form O to be capable of being prepared only in a range in which a total amount of the buying form I is not exceeded, and erasing the original buying form I at a time of preparation of the shipping form O (col 4 paras 26 & 32).

18. Regarding Claims 10-11: The limitations of claims 10-11 are similar to the claims of 1-9. Therefore they are rejected based on the same rationale, supra.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FAHD A. OBEID whose telephone number is (571)270-3324. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fahd A Obeid/
Examiner, Art Unit 3627
08/26/2008

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627